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Patricia Kewes
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In re application of: Karpenko

Application No.: 09/390,937 ✓

Filed: September 7, 1999

Title: SELF-PAYING SMART UTILITY METER
AND PAYMENT SERVICE

Attorney Docket No.: VISAP022

Examiner: Dixon, Thomas A

Group: *3629*
2161

Confirmation No.: 7838 Technology Center 2100

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Laura M. Dean
Laura M. Dean

RESPONSE TO RESTRICTION REQUIREMENT

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GROUP 3600

Commissioner for Patents
Washington, DC 20231

Dear Sir:

The Applicant is submitting this paper in response to the Examiner's Action mailed April 4, 2002, requiring that an election be made before a three-month shortened statutory period for response.

Pursuant to 37 C.F.R. § 1.143, the Applicant hereby requests reconsideration and withdrawal or modification of the requirement.

Discussion

Restriction is proper only when the inventions are independent or distinct as claimed and there is a serious burden on the examiner prior to a restriction requirement. MPEP §803.

Serious Burden

The Applicant respectfully submits that the Examiner has not made a prima facie case that analyzing the entire application would be a serious burden. MPEP § 808.02 states, "Separate status in the art may be shown by citing patents which are evidence of

such separate status, and also of a separate field of search.” Neither patents showing separate status nor a separate classification was provided. The extent of the Examiner’s finding was, “Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.” Office Action, April 4, 2002, ¶ 4. This conclusory statement is not enough to “establish reasons for insisting upon restriction.” MPEP § 808.02.

Where the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. *Id.* Since the Examiner has made so much showing, the Applicant traverses the Examiner’s assertion.

Distinctiveness - Inventions I and II

The Examiner stated, “invention I has separate utility such as simply receiving the data at a host site and processing it, invention II has separate utility such as simply monitoring utility usage and sending data to a host.” Office Action, April 4, 2002, ¶ 2.

Claim 10 (of invention II) recites, in part, “transmitting the utility message to the processing center, the processing center being arranged to substantially initiate . . . [a] transaction for payment for the usage of the utility.” Presumably, the quoted recitation is where the Examiner derived the utility “sending data to a host.” However, claim 1 (of invention I) recites, in part, “transmitting the amount to a second remote location, . . . wherein the second remote location is arranged to effect a payment of the amount by the customer.”

Since both claim 1 and claim 10 describe sending data to a system (the Applicant disagrees with the characterization of the system as a “host.” Merriam-Webster’s Collegiate Dictionary, found at <http://www.m-w.com>, defines “host” as “a computer that controls communications in a network.” The system to which data is being sent does not necessarily “control” communication.), the Applicant traverses the Examiner’s assertion.

Distinctiveness - Inventions III and IV

The Examiner stated, “invention III has separate utility such as simply monitoring utility usage and sending data to a host.” Office Action, April 4, 2002, ¶ 3. No mention is made of invention IV. It is noted that the described utility of invention III is identical in wording to the described utility for invention II.

It is submitted that the Examiner has not made the required showing for distinctiveness. The Examiner stated, "Inventions III and IV are related as process and apparatus for its practice." *Id.* However, MPEP § 806.05(e) states, "Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process." The Examiner has made no such showing.

The entirety of the Examiner's argument was "invention III has separate utility such as simply monitoring utility usage and sending data to a host," which has absolutely no bearing on distinctiveness for process and apparatus for its practice. It is noted that "the burden is on the examiner to provide reasonable examples that recite material differences." MPEP § 806.05(e).

Provisional Election

Pursuant to 37 C.F.R. § 1.143, the applicant provisionally elects the invention of claims 1 - 9 and 24 - 26.

Conclusion

The Applicant believes that this paper is responsive to each and every ground of restriction cited by the Examiner in the Action dated April 2, 2002, and respectfully requests favorable action in this application.

Please apply any charges not covered, or any credits, to Deposit Account 50-0388 (Reference No. VISAP022).

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP


Morgan E. Malino
Registration No. 41,177

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P.O. Box 778
Berkeley, CA 94704-0778
(650) 961-8300